

What to do if you Suspect Infringement

As a holder of intellectual property (IP) rights you have the tools you need to protect the results of your creativity and innovation. Patent owners benefit from exclusive rights to the invention claimed. The monopoly provided by your patent rights can really give you the edge in your market. But what should you do when an unauthorised party seems to be exploiting your protected technology and eroding your commercial advantage?

Don't take rash action

You need to be careful how you handle the situation, even if you are under pressure to underline your market position. Don't be tempted to approach or write to the suspected infringer, or particularly their customers without first seeking professional advice. Threats made in the wrong way or against the wrong person could give anyone that suffers damage as a result a claim against you. Any ill-worded statements made at this stage could also be used against you later in court.

A professional adviser such as a qualified patent attorney can review the situation for you and advise whether there are genuine grounds to suspect infringement and, if so, how to deal with it.

Collecting evidence of infringement

If you have a patent in force in the UK then directly infringing commercial activities include importing, selling, using or offering to sell a patented product or carrying out a patented process, in the UK. You should keep a record of all suspected infringing acts, e.g. what is being manufactured or offered for sale, when it is supplied, and by whom. Try to obtain samples of any products you suspect of infringing.

First steps to resolving the situation

Your adviser will advise how best to take action, and against whom. Typically this involves writing to the suspected infringer to draw attention to your patent. This could be enough for them to stop their activities. However, if they keep operating regardless then you may have to exercise your patent rights against them. Sometimes more urgent action is necessary to prevent irreparable damage or destruction of evidence.

A potential licensing opportunity?

If the infringer is not your direct competitor or there is room for both of you in the market, then you could consider offering them a licence to operate within the scope of your patent. This could earn you royalty fees and save you both the time and expense of legal proceedings.

Seizing infringing goods before they harm your business

If you become aware that products infringing patents or any other IP rights are going to be imported into the UK from outside the EU, then you can apply to UK customs authorities for goods to be seized upon entry to the country. They may be detained for a short time in while you try to resolve the problem but if no legal proceedings are launched they will be released again. Similar arrangements are available in other EU countries.

Taking definite action

If you cannot reach an agreement and you want to put a stop to the infringer's activities then you may need to initiate legal proceedings. Civil actions for UK patent infringement may be heard by the Patents County Court or the Patents Court in the Chancery Division of the High Court.



If there is the likelihood of irreparable harm you may be able to apply for an emergency interim injunction against the infringer, although these are rare. When the Court decides your case you can be awarded remedies, including: a permanent injunction; compensation in the form of damages or an account of profits; and an order for delivery up or destruction of infringing goods.

The realities of patent litigation

Before you decide to take legal action you should weigh the costs involved against what you hope to achieve. Court proceedings involve a financial risk as the case may be decided against you and you could be ordered to pay the other side's legal costs. Launching an infringement action also puts your patent at risk as the accused infringer is likely to make a counter-claim against you, challenging the validity of your patent. You should bear in mind that it can take 12-18 months for the court to hear your case so there is quite a period of uncertainty involved.

Of course a suitably qualified adviser can help you to negotiate the minefield of legal proceedings. They can help you to negotiate a settlement or take advantage of alternative dispute resolution measures such as mediation.

Keeping an eye on the global picture

Patents are territorial rights and thus you may need to take action separately in each country where you have a patent in force. Specialist advice is required if multi-national litigation is contemplated.

Prevention is better than cure

You can take steps to deter potential infringers and safeguard your position as a unique market player. Putting others on notice of your patent rights can be important if you later want to claim back-dated compensation. It is good practice to mark your products, promotional literature, website, etc. with the patent application or patent number(s). Keep an eye on your competitors so that you can spot infringing activities as soon as they start and take action swiftly.

Making the most of your IP assets

Patents are powerful tools for protecting your business interests and bolstering your market position. Please contact any of our patent attorneys if you would like further advice on enforcing them.

Further advice

If you would like any further advice please contact us at Dehns using the details below.

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